

Remarks

In response to the Office Action mailed September 17, 2008, claims 1-20 have been amended and claims 21-23 are newly added. In addition, the Specification has been amended. Support for the instant amendments and new claim may be found throughout the embodiments disclosed in the originally filed Specification. Thus, no new matter has been added. Accordingly, claims 1-23 are pending.

Reconsideration and allowance of the pending claims, based on the following remarks are respectfully requested.

Restriction/Election

Applicant hereby affirms the election, with traverse, to prosecute claims 11-20 (Group II) drawn to an apparatus for molding an electronic component with a compound.

MPEP § 1983.03(d) provides:

When making a lack of unity of invention requirement, the examiner must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group.

The Office Action alleges that "molding of an electronic component" is a common special technical feature of both Groups I and II, and that EP 0971410 teaches a resin molding machine for manufacturing semiconductor devices. [See Office Action, pg. 2]. Applicant respectfully disagrees with both these assertions.

"The expression 'special technical features' shall mean those technical features that define ***a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.***" PCT Rule 13.2 (emphasis added); see also MPEP § 1983.03(d). Applicant acknowledged that EP 0971410 generally discloses a method and apparatus for covering an electronic component with a compound. [See

Applicant's Specification, pg. 1, lines 4-5]. Thus, Applicant submits that this is not the specifically technical feature of either Group I or II.

By contrast, Group I: independent claim 1 recites, *inter alia*, the features of:

regulating and adjusting the distance between the two mold halves while the two mold halves are moved towards each other and while the two mold halves are held in a position after having been moved towards each other during curing of the compound.

Similarly, Group II: independent claim 11 recites, *inter alia*, the features of:

a controller configured to control the positions of the at least one actuator, so that the distance between the two mold halves is regulated and adjusted while the two mold halves are moved towards each other and while the two mold halves are held in a position after having been moved towards each other.

The Office Action has not shown how EP 0971410 teaches these features of Groups I and II. In addition, Applicant notes that since the inventions of Groups I and II are related as method and apparatus for carrying out the method that they should be examined together. "An apparatus or means is specifically designed for carrying out the process when the apparatus or means is suitable for carrying out the process with the technical relationship being present between the claimed apparatus or means and the claimed process." MPEP § 1983.03(d).

Accordingly, Applicant submits that the Restriction Requirement is improper and should be withdrawn.

Claim Objection

Claims 11-20 were objected to under 35 U.S.C. § 1.75(c) as allegedly being in improper form. In particular, the Office Action alleges that claims 11-20 are improper multiple dependent claims. Applicant traverses this objection for at least the following reasons.

First, even though the application included multiple dependent claims, only claim 14-20 might have been in improper form. Indeed, independent claim 11 and dependent claims 12 and 13 were proper and thus, should have been previously examined.

Second, Applicant submits that the features recited in claims 14-20 should have also been examined. Indeed, 37 C.F.R. § 1.104(a)(1) provides: "On taking up an application for examination ..., the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination **shall be complete** with respect both to compliance of the application ... with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated." (emphasis added). Accordingly, it does not follow that the claims should not have been further treated on the merits, as the Office Action states.

Notwithstanding the improper treatment of claims 11-20, on the merits, Applicant has amended the claims to remove the multiple dependent claim recitations.

For at least the foregoing reasons, the objection of claim 11-20 is improper and should be withdrawn.

Conclusion

Having addressed each of the foregoing matters, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Date: **December 17, 2008**

Respectfully submitted,

By:



Eric B. Compton
Registration No. 54,806

Customer No. 00909

PILLSBURY WINTHROP SHAW PITTMAN LLP
P.O. Box 10500
McLean, Virginia 22102
Main: 703-770-7900
Direct Dial: 703-770-7721
Fax: 703-770-7901